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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,717	01/26/2004	Martin Blaze	CUNO-330.2	8658
45017	7590	11/23/2004		
CUNO INCORPORATED 400 RESEARCH PARKWAY P. O. BOX 1018 MERIDEN, CT 06450-1018			EXAMINER CECIL, TERRY K	
			ART UNIT 1723	PAPER NUMBER

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,717

Applicant(s)

BLAZE ET AL.

Examiner

Mr. Terry K. Cecil

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-31 and 33-43 is/are pending in the application.
- 4a) Of the above claim(s) 16-23 and 38-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, 24-31 and 33-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-9-2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 10-15, 24-31 and 33-37, drawn to an apparatus and method for handling filter disks, classified in class 210, subclass 237.
 - II. Claims 16-23 and 38-43, drawn to a filter assembly, classified in class 210, subclass 323.1.
2. The inventions are distinct, each from the other because of the following reasons:
 - Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination of Invention II does not require the “means for facilitating lifting..” of Invention I. The subcombination of Invention I has separate utility such as in a filter housing assembly that does not require the base member having both an inlet and outlet portion and the insert assembly of Invention II.
 - Restriction for examination purposes is proper because of the reasons given above and also because (i) they have acquired a separate status in the art as shown by their different classification, (ii) the search required for the respective groups is not coextensive with the

search required by each of the other groups, and (iii) their subject matter is recognized as divergent.

3. During a telephone conversation with T. Payne on 11-16-2004 a provisional election was made with traverse (provisionally) to prosecute the invention of claims 1-8, 10-15, 24-31 and 33-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16-23 and 38-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to because of the following reasons:
- Figure 9c should be designated by a legend such as --Prior Art-- because only that which is old is illustrated—as per applicant's specification, page 12, line 23. See MPEP § 608.02(g).
 - The drawings fail to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description: "70" (page 14, line 23).
 - The drawings fail to comply with 37 CFR 1.84(p)(5) because they include the following reference character not mentioned in the description: "90" (figure 3). Did applicant intend for "90" to be "70" in figure 3?

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application for the reasons mentioned above. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new

drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-8, 10-15, 25-31 and 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because of the following reasons:

- Since the apparatus of claim 1 includes at least one filter disk (as claimed), it is unclear how the filter disk can be separated from the apparatus (itself) in lines 8-9 of claim 1. Did applicant intend to claim "...such that apparatus said center post member is separated from the at least one filter disk by sliding the apparatus center post member out from the at least one filter disk..." For the same reasons, "apparatus" in line 12 should be changed to "center post member". The indefinite rejection of claim 1 also applies *mutatis mutandis* to claim 25.

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- Claims 7-8, 10-15, 25-31 and 33-37 are also rejected since they suffer the same defects as the claims from which they depend.

Claim Objections

7. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Since the remote location is not part of the apparatus, it is not seen how further describing the remote location further structurally defines applicant's invention (claim 25 already requires the filter disc to be separable from the apparatus).

Specification Objection

8. The abstract is objected to because of misspelled and duplicate words.

9.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

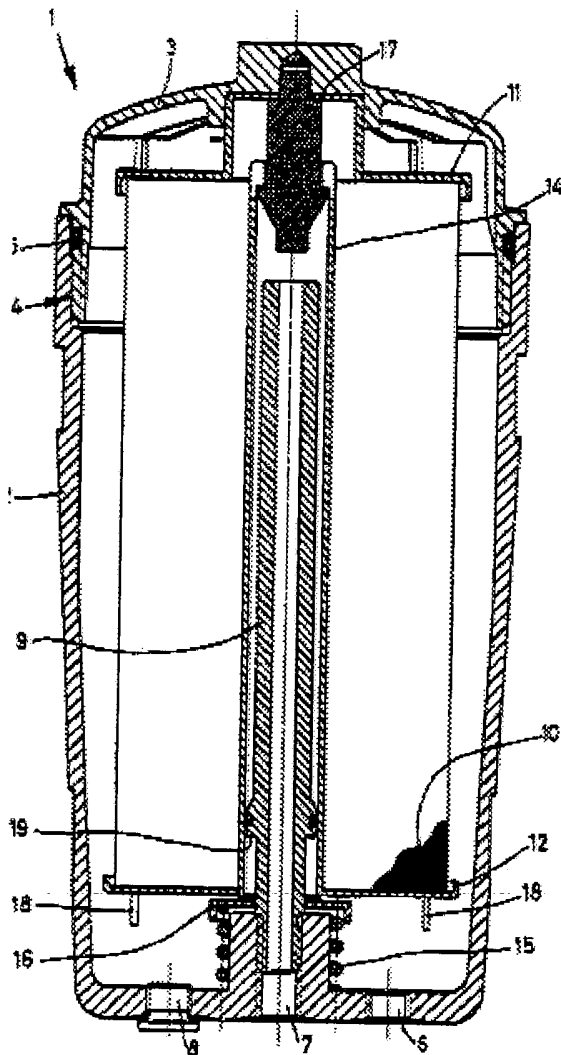
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

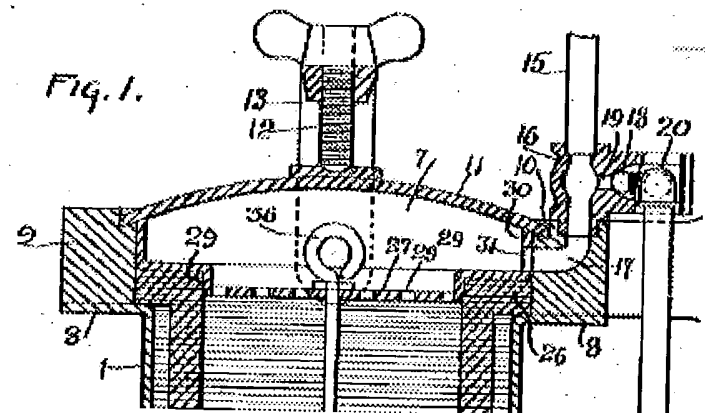
11. Claims 1 rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19541965C1, hereinafter '965 in view of Blackmore (U.S. 1,701,556). '965 teaches an oil filter including a



plurality of filter disks 10 clamped between end plates 11 and 12 and including a center post member (17+14) wherein the disks are slidable thereon. The apparatus is configured such that elements 17, 14, 10, 11, 12 and 9 are lifted out of the casing 2 in unison for servicing/replacing the disks. At such time the cover plate 11 is removed and the disks are slid off the post member. Either or both of elements 9 and 16 are considered to be the claimed "adapter member" that is "operatively connected" to the post member 14 whenever the disks are "operatively positioned" [as in claim 1].

'965 doesn't teach the post member (17+14) to include an attachment means including a means for lifting the disk (Note that the equivalent structure in the specification for

this "means for" limitation is the eyebolt, hoist ring, or lifting eye of page 7, lines 19-25).



However such is taught by Blackmore. Blackmore also teaches an oil filter including a plurality of disks 24 (more than 56) [as in claims 10-11]) that also includes an attachment means including a means for facilitating lifting (36) of the disks [as in claim 1]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention for the top of the post member (17+14) to include the eyebolt 36 of Blackmore, since Blackmore teaches the benefit of facilitating removal of the filter assembly by e.g. a hook so that the hands of the operator will not be soiled (page 1, lines 78-81). As for claim 5, upon removal of the filter assembly from the casing 2, the limitations thereof are met. As for claim 15, the disks can slide over the end of the post member. As for claim 13, the adapter member 9 includes a flow passage therethrough. As for claim 14, the exact shape (e.g. semi-circular) of the aperture (discharge passage) is within ordinary skill and is insufficient per se for patentability of the claim. For example in uses requiring a small volumetric flow rate, it is obvious for the discharge passage to have a smaller cross-sectional area of a semicircle. As for claim 12, Blackmore teaches the idea of the end of a post 32 to be threaded to attach to a complimentary threaded portion. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the end of the adapter 9 of '965 to be threaded and to engage a complementary threaded opening (7), since Blackmore teaches the benefit of rigidly securing the assembly.

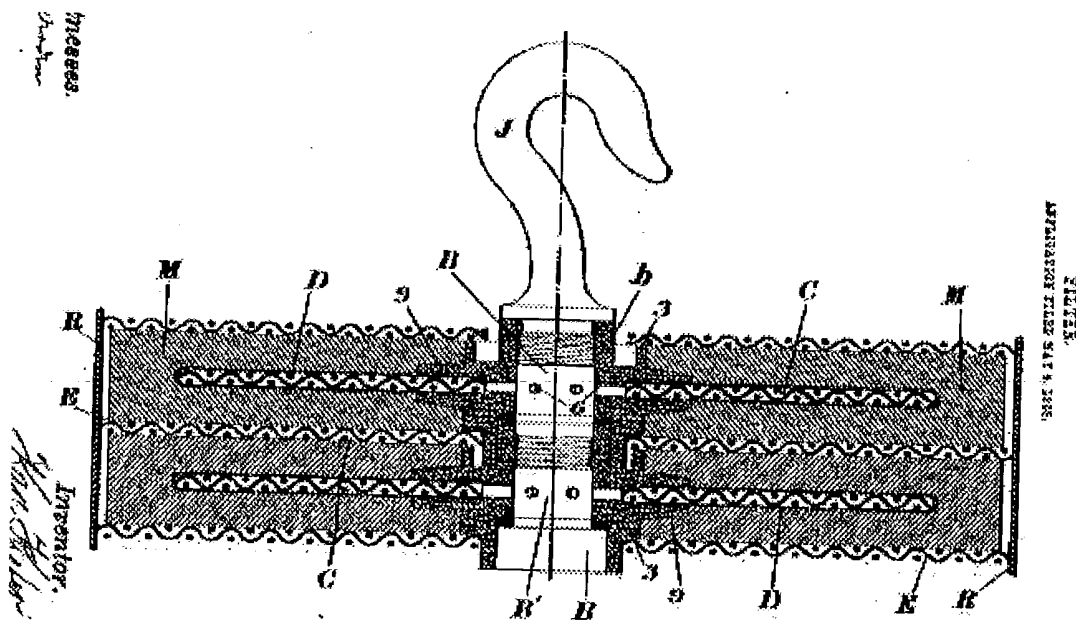
12. Claims 2-3, 24-26, 28, 33-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965, in view of Blackmore as applied above and in further view of FR 2,460,154, hereinafter "154". As expanded above '965 in view of Blackmore teaches the limitations of claims 28 and 33-37 but does not teach a motor-powered lifting apparatus. As shown in figure 5,

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'154 teaches a motor powered lifting apparatus [as in claims 2-3 and 25-26]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the lifting apparatus of '154 in the invention of the modified '965, since '154 teaches the benefit of removing a filtering apparatus from a housing for the servicing/replacing of the filter units.

Upon modification of '965 with that taught in Blackmore and '154, the claim method of claim 24 is also taught.

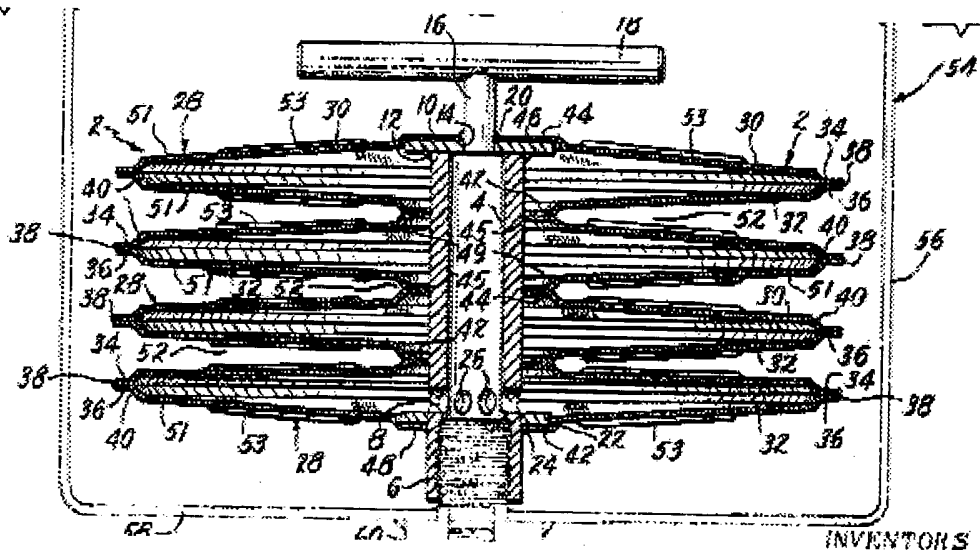
13. Claims 6 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965 as respectively modified in the rejections of claims 1 and 25 above and in further view of Kiefer (U.S. 781,830).



Kiefer teaches a threaded hook received by a threaded post [as in claims 6 and 29]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the threaded configuration of Kiefer in the inventions of the modified '965, since Kiefer teaches the benefit of a means for lifting a filter disc assembly.

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14. Claims 8 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965 as respectively modified in the rejections of claims 1 and 25 above and in further view of Boggs et al. (U.S. 3,666,107).



Boggs teaches a lifting member (10+16+18) welded to a center post [as in claims 8 and 31]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the modified means for lifting of '965 to be welded to the post member (17+14) thereof as in Boggs, since Boggs teaches the benefit of a means for lifting a filter disc assembly.

15. Claims 7 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over '965 as respectively modified in the rejections of claims 1 and 25 above and in further view of Lock (U.S. 2,630,610). Lock teaches a swiveled hook ring. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the ring of the modified '965 to be swiveled as in Lock since such would allow the connection to the lifting means to be rapidly made.

16. Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over '965 in view of Blackmore and '154 as applied above and in further view of Broyden et al. (US 4,635,903). Broyden teaches a manually operated chain hoist [as in claims 4 and 27]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the lifting means to be manually operated since Broyden does not require a lot of physical strength to operate the chain hoist and the operator can precisely raise the load to a particular height without worrying about accidentally dropping the load.

Response to Arguments

17. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

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18. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is 703-872-9306.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mr. Terry K. Cecil
Primary Examiner
Art Unit 1723

TKC
November 17, 2004